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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,016	02/20/2003	Elazar Sonnenschein	A34908PCTUSA;066031.0169	5998
21003	7590	09/02/2004	EXAMINER	
BAKER & BOTTS 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 09/02/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/030,016

Applicant(s)

SONNENSCHIN ET AL.

Examiner

John P. Leubecker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 December 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Drawings

1. Figures 1, 2A-2E, 3A-3C, and 4A-4C should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).
2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "4" has been used to designate position markings (Fig. 7, page 20), relay (e.g., Fig. 2A, page 14), right angle prism (Fig. 9A, page 21) and the distal end (Fig. 7, page 19). In addition, reference character "1" has been used to designate the activator (Fig. 10, page 20), the objective lens (Fig. 9A, page 20) and pocket (Fig. 8A, page 19), video monitor (Fig. 11, page 20) and socket (Fig. 10, page 21). In addition, reference character "2" has been used to designate the fixed section (Fig. 8A, page 19), "stapler view" (Fig. 11, page 20) and a flexible fiberoptic image guide (Fig. 9A, page 20). **The above mentioned defects are examples and do not point out ALL of the defects in the drawings. Applicant is required in response to this Office Action to review the drawings and correct ALL defects.**
3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the combination of the endoscope, stapler and both separately located optical systems must be shown or the feature(s) canceled from the claim(s). Although Figure 10 shows an endoscope with a distally located optical system (with no stapler components) and Figures 9A and 9B show an endoscope with two separately located optical systems, no single Figure or combination of Figures adequately illustrates, for the purposes of understanding the recited combination, the combination as claimed

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in claim 7. An attempt to translate elements between Figures 9A and 10 creates confusion since the reference numbers appear to fail to indicate corresponding elements. Even if the reference numerals did correspond, since the stapler components are left out of the drawings, the relative locations and orientations of the multiple optical systems with respect to the stapler components is vague at best, or would not even be shown. No new matter should be entered.

4. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

5. The abstract of the disclosure is objected to because it should not begin with the phrase "The present invention relates to". Furthermore, the abstract should be a concise statement of the technical disclosure and not discuss purported uses or merits of the apparatus. Correction is required. See MPEP § 608.01(b).

Claim Objections

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6. Claims 6 and 7 are objected to because of the following informalities: as to claim 6, lines 2-3, "each of each of" should be --each of--; as to claim 7, lines 11 and 13, "to display apparatus" should be --to a display apparatus--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

7. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 1, term "optionally" makes the claim indefinite as to whether the elements following this term are required by the claim or not. Furthermore, recitation of the combination "also including" an optical relay system, an ocular and a coupling lens/image sensor appears to be redundantly reciting elements covered by the means of capturing or viewing the image that is previously recited.

As to claim 2, this claim is indefinite since it can not be determined as to what it is claiming. It is not clear if the requirement of a "single optical channel" is part of the "two or more separate optical channels" claimed in claim 1 or if it is contradicting the requirement for two or more.

As to claim 6, phrase "may be of any suitable shape, including, but not limited to circular and rectangular" is indefinite as to how this further limits the scope of the claim. It appears to be an open ended, non-limiting statement that makes the reader wonder if one of the two specific examples (i.e., circular and rectangular) is required by the claim.

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As to claim 7, terms "the tip of said articulated section", "said articulating tip", "said distal tip" and "the flexible sheath" lack antecedent basis. It is not clear whether the first three mentioned terms are referring to the same element or to different elements. The fourth term indirectly refers to the sheath as "flexible" (when it was not previously mentioned as such) or is possibly referring to a different element.

As to claim 10, this claim attempts to further limit an element (i.e., the elements of the stapling device) that is not positively claimed in claim 8 (i.e., suitable to receive elements of the stapling device indicates a capability of the socket and does not require the elements of the stapling device as part of the claimed combination). Hence, this claim does not appear to further limit the claimed combination.

Dependent claims inherit those defects.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kuramoto et al. (U.S. Pat. 5,395,030).

As to claims 1 and 7 and referring mainly to Figures 22 and 23, Kuramoto et al. disclose a sheath (137) provided with a distal articulated section (142), stapler components (124,146) distributed between a first location at a tip of the articulated section (Fig.22) and a second location along the length of the sheath (Fig.22), wherein the stapler components are capable of being brought into a cooperative working positioned relationship (Fig.23) by articulation of the articulated section, a first objective lens (144) located on the tip of the articulated section and a second objective lens (122) located at the second location along the sheath. Note col.6, line 67 to col.7, line 10 for components of the objective optical system. As to claim 2, single or multiple views can be obtained (since either or both objective lenses could be used). As to claim 3, the optical system operates at least in the visible spectrum (the optical system is for visualization). As to claim 4, the objective lenses have fixed focal lengths (there not disclosed as variable). As to claim 5, the view are at an angle of between 0 and 180 degrees (note Figure 22). As to claim 6, the fields of view are suitable and the angular views are up to 180 degrees or more (which encompasses all angular views).

With respect to claims 8-10 and referring mainly to Figure 34, Kuramoto et al. disclose an endoscope including a socket (172) suitable to receive elements of a stapling device, at least one illumination channel (168, Fig.33), at least one objective optical system (167, note col.6, line 67 to col.7, line 10 for components of the objective optical system) and a channel (171). In the case that the stapling device is eventually claimed in the combination, note anvil (174). Also note that the embodiment of Figures 22 and 23 would meet the limitations of claims 8-10.

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10. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Yoon (U.S. Pat. 6,387,043).

Yoon discloses an endoscope comprising two or more separate optical channels that produce two or more distinct views, each consisting of an objective lens and a means of capturing or viewing the image (all shown in Figure 8). Note that the objective lenses associated with the imaging means (238,222) are located at different positions along the length of the endoscope (Fig.8). As to claim 2, single or multiple views can be obtained (since either or both objective lenses could be used). As to claim 3, the optical system operates at least in the visible spectrum (col.2, lines 37-38). As to claim 4, the objective lenses have fixed focal lengths. As to claim 5, the view are at an angle of between 0 and 180 degrees (note Figure 8). As to claim 6, the fields of view are suitable and the angular views are up to 180 degrees or more.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over El Gazayerli (U.S. Pat. 6,159,146) in view of Kuramoto et al. (U.S. Pat 5,395,030).

El Gazayerli disclose a sheath (12) provided with a distal articulated section (28) and stapler components (16,24) distributed between a first location at a tip of the articulated section

(Fig.2A) and a second location along the length of the sheath (Fig.2A), wherein the stapler components are capable of being brought into a cooperative working positioned relationship (Fig.2C) by articulation of the articulated section. A separate viewing device (14) (which inherently requires an objective lens, optical channel and a display apparatus—note laparoscopes and gastroscopes are specifically mentioned) views from a remote location proximate both stapler components (Figure 1). Thus, El Gazayerli fails to disclose two optical systems, one located on the tip of the articulated section and a second one located at the second location along the sheath. However, Kuramoto et al. teaches use of an observation means (e.g., objective lens and optical channel) adjacent both components of a stapling device (i.e., adjacent the cartridge and anvil) so as to allow the surgeon to “see and check the state the walls assume immediately after they have been stapled” (col.13, lines 33-45). It would be evident to one of ordinary skill in the art that such modification would be significant improvement in the El Gazayerli device since it would desirably provide direct visualization of the stapled site as opposed to an oblique view from a remote location (Fig.1 of El Gazayerli). It would therefore have been obvious to one of ordinary skill in the art in view of the teaching of Kuramoto et al. to have provided two observation means adjacent the cartridge (16) and the anvil (24) of El Gazayerli instead of using a separate viewing device for the reasons taught above.

The modification proposed above with respect to the El Gazayerli reference would then anticipate claims 1-6.

Conclusion

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Yamamoto et al. (U.S. Pat. 6,059,719) and Page et al. (US 2003/0171651)—note that the endoscope and socket for accepting instrument tips would meet limitations of at least claim 8.

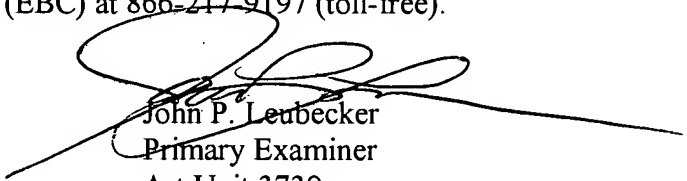
Also note Kolff et al. (U.S. Pat. 5,976,076) regarding claim 1.

Also note Adams (US 2003/0220657) and Kortenbach (US 2004/0010271) with regards to the combination of endoscope and stapler.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (703) 308-0951. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (703) 308-0994. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner
Art Unit 3739

jpl